



UNITED STATES PATENT AND TRADEMARK OFFICE

A

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,962	02/08/2002	Stephen B. Sutherland	WH-11 109-1US	7929

26123 7590 07/26/2005

BORDEN LADNER GERVAIS LLP
WORLD EXCHANGE PLAZA
100 QUEEN STREET SUITE 1100
OTTAWA, ON K1P 1J9
CANADA

EXAMINER

LIN, KENNY S

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,962

Applicant(s)

SUTHERLAND ET AL.

Examiner

Kenny Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 9-11 are presented for examination. Claims 1-8 and 12-21 are canceled.

Priority

2. Applicant is reminded again that although acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on February 9, 2001. It is noted that applicant has not filed a certified copy of the Canada 2,335,395 application as required by 35 U.S.C. 119(b).

Election/Restrictions

3. Applicant's election without traverse of claims 9-11 in the reply filed on 7/14/2005 is acknowledged.
4. Claims 1-8 and 12-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/14/2005. Claims 1-8 and 12-21 are canceled.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2154

6. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following terms lack proper antecedence basis:

- i. Claim 9, lines 5 and 8 – “the user”;
- ii. Claim 11, line 3 – “the user” (is this referring to “any recorded user” in line 2?).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Tornabene et al (Tornabene), US 2002/0023132.

9. As per claim 9, Tornabene taught the invention as claimed including a photosharing wide area computer network comprising a web server storing digital images associated with particular users and allowing each particular user to authorize others to access the digital images of the particular user (pp. 0006-0007, 0084, 0091; members sharing data files such as photographs),

Art Unit: 2154

said web server providing each user with an invitation procedure for inviting others to access the images controlled by the user (pp. 0006, 0012, 0074-0077, 0079-81), said invitation procedure including creating an invitation which includes an authorization segment and forwarding the invitation electronically to a designated invitee at a particular address (pp. 0006, 0046, 0080-0081, 0085, 0094-0096), said designated invitee using said invitation to contact the web server and provide access to said images controlled by the user in accordance with said authorization segment (pp. 0006, 0080-0085, 0091).

10. As per claim 10, Tornabene taught the invention as claimed in claim 9. Tornabene further taught that invitees access said web server using a computer and the internet (pp. 0006-0007, 0012, 0079-82; email, chat, instant message all require the use of computer and the internet).

11. As per claim 11, Tornabene taught the invention as claimed in claim 9. Tornabene further taught that upon contact with the web server any recorded user has a listing of photo albums and said photo albums include personal photo albums and photo albums which the user and received authorization to share (pp. 0006-0007, 0009, 0091).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barraclough et al, US 6,301,607.

Kahuta et al, US 6,714,965.

Tessman, JR et al, US 2002/0135801.

Wood et al, US 6,732,162..

Anderson, US 2002/0087622.

Ichikawa et al, US 6,914,694.

Vertelney et al, US 6,760,884.

Morris, US 6,871,231.

13. A shortened statutory period for reply to this Office action is set to expire **THREE MONTHS** from the mailing date of this action.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2154

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
July 21, 2005



JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100